

REMARKS

By virtue of this response, claims 26-29 have been amended, and new dependent claims 31-38 have been added. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented. Amendment of the specification on page 1 updates related application information and as such does not constitute new matter. Support for the amendment of the claims and new claims can be found in general throughout the specification *e.g.*, on pages 10 and 11, and in the claims as originally filed. No new matter has been added.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is entitled "**VERSION WITH MARKINGS TO SHOW CHANGES MADE**".

The Examiner has indicated that claim 30 is withdrawn as directed to a non-elected species. Applicants submit that claim 30 should be reinstated. As noted in the Office Action dated October 5, 2000, Applicants are entitled to consideration of claims to additional species which are written in dependent form upon allowance of a generic claim.

Double Patenting Rejections

Claims 20 and 22-29 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-8 of U.S. Patent No. 5,993,805.

Filed herewith is a terminal disclaimer regarding co-owned U.S. Patent No. 5,993,805, rendering the rejection moot. Applicants therefore respectfully request withdrawal of the rejection.

Claim 21 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 5, 993,805 in view of Goldberg et al., 4,671,954.

Filed herewith is a terminal disclaimer regarding co-owned U.S. Patent No. 5,993,805, rendering the rejection moot. Applicants therefore respectfully request withdrawal of the rejection.

Rejections under 35 U.S.C. §112

Claims 26-29 are rejected under 35 U.S.C. §112 second paragraph, as indefinite.

Applicants have amended claims 26-29 to depend from claim 20. Applicants therefore respectfully request that the rejection be withdrawn.

Concerning Maudling (Reference #12, Supplemental IDS, filed March 22, 2000)

A substitute PTO-1449, including the publication date and journal title of the above-mentioned article, is submitted herewith, as requested by the Examiner. The Applicants respectfully request that the Examiner initial and return to the Applicants the substitute PTO-1449 indicating that the Maudling article is made of record in the application

CONCLUSION


Applicant has, by way of the amendments and remarks presented herein, made a sincere effort to overcome rejections and address all issues that were raised in the outstanding Office Action. Accordingly, reconsideration and allowance of the pending claims are respectfully requested. If it is determined that a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 263742002801. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: July 23, 2001

By:



Madeline I. Johnston
Registration No. 36,174

Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, California 94304-1018
Telephone: (650) 813-5840
Facsimile: (650) 494-0792

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

Please replace the paragraph at page 1, line 4 with the following:

--This Application is a continuation of Application Serial No. 08/487,420 filed June 7, 1995, now U.S. Pat. No. 5,993,805, which is a continuation-in-part of Application Serial No. 07/956,875 filed March 11, 1993, now U.S. Pat. No. 5,518,709.--

In the Claims:

Please amend claims 26-29 as follows:

26. (Amended) The composition according to claim [1] 20, wherein said water-soluble material is an amino or polyamino acid.

27. (Amended) The composition according to claim [1] 20, wherein said water-soluble material is a protein, peptide or enzyme.

28. (Amended) The composition according to claim [1] 20, wherein said water-soluble material is a human protein or fragment or recombinant thereof.

29. (Amended) The composition according to claim [1] 20, wherein said water-soluble material is a protein with a NH, CO, OH or SH retained functional group.